

REMARKS

Applicant has carefully reviewed the Office Action of March 1, 2005, and offers the following remarks to accompany the above amendments.

Applicant endeavored to schedule a telephonic interview for the present application. On May 10, 2005, the Examiner indicated that he would call back with a suggested time. However, no such call has been made and the present response is prepared and filed without the benefit of the interview. In the event that a telephonic interview has not been scheduled by the time that the Examiner reviews this Office Action, Applicant requests that the Examiner contact the undersigned so that a telephonic interview can be scheduled before the generation of the next Office Action.

Claims 1-26 were rejected under 35 U.S.C. § 112 as failing to set forth the subject matter which Applicant regards as their invention. In particular, the Patent Office opines that the term "user" is ambiguous and does not delineate what the user is using. Applicant respectfully traverses. Applicant initially notes that ambiguity is not the basis for failing to set forth the subject matter which Applicant regards as their invention. The bases for rejection a claim under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which Applicant regards as their invention, can be found in MPEP § 2172. That section states in relevant part:

A rejection based on the failure to satisfy this requirement is appropriate only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims. In other words, the invention set forth in the claims must be presumed, in the absence of evidence to the contrary, to be that which applicants regard as their invention.

The next section of MPEP § 2172 states that statements made in prosecution history and in admissions can be evidence that the claims do not cover what Applicant believes is the invention. Nowhere within the standard is there any indication that a rejection is proper under § 112 for failing to set forth the subject matter which Applicant regards as their invention because a claim may be ambiguous in the eyes of the Patent Office.

If the Patent Office wishes to recharacterize the rejection as one wherein the claims do not particularly point out and distinctly claim the invention pursuant to 35 U.S.C. § 112, second paragraph and MPEP § 2173, then the Patent Office should so state. Applicant proceeds as if the Patent Office had done so.

MPEP § 2173.02 sets forth the appropriate inquiry for a rejection under 35 U.S.C. § 112, second paragraph as not particularly pointing out and distinctly claiming the invention.

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
 - (B) The teachings of the prior art; and
 - (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.
- In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph

Under this standard, Applicant's claims are precise. The term "user", when considered in the context of the application disclosure, is a well understood term to someone possessing an ordinary level of skill in the art. Applicant notes that "user" is commonly used in patent claim drafting and can be found in countless issued patents with no more specificity than that found in the present claims. Applicant requests withdrawal of the § 112 rejection at this time.

Claims 1-14 were rejected under 35 U.S.C. § 101 as setting forth non-statutory subject matter for failing to change physical matter. Applicant respectfully traverses. Applicant notes that 35 U.S.C. § 101 does not state that changing physical matter is required to be statutory subject matter. Furthermore, the Supreme Court and the Federal Circuit have repeatedly indicated that any process under the sun falls with the definition of "process" used in the statute. *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1368 (Fed. Cir. 1998).

Regardless, Applicant herein amends claim 1 to recite a presence detection system, which constitutes a tangible item and falls within the Patent Office's asserted interpretation of 35 U.S.C. § 101. If the Patent Office maintains this rejection, Applicant reserves the right to provide further evidence that the Patent Office's interpretation of §101 is overly simplistic, and is not the current standard for a rejection under 35 U.S.C. § 101.

Before addressing the rejections based on the references, Applicant provides a brief summary of the present invention so that the remarks relating to the references are considered in the proper context. The present invention is designed to improve presence systems and the resultant routing of incoming communications to the user. The present invention improves

existing systems by distributing the creation of the “service logic” to the presence detection systems. The service logic is defined in paragraph 0005 of the specification to be that which instructs an associated presence service to control communications associated with the user based on presence. The presence detection systems not only detect whether a user is present, but also generate the service logic. Having generated the service logic, the service logic is then passed to the presence service. The original claims attempted to capture this distribution element through the claim language corresponding to “providing the service logic to the presence service.” Applicant’s amendment to claims 1, 15, and 27 highlight that the service logic is created in the at least one presence detection system and pass the service logic to the presence system. Support for these amendments can be found in at least paragraph 0005 of the specification as originally filed. No new matter is added. This distributed generation of the service logic is not shown by the references of record.

Claims 1-8, 11-22, 25-34, 37, and 38 were rejected under 35 U.S.C. § 102(e) as being anticipated by Boyer et al. (hereinafter “Boyer”). Applicant respectfully traverses. For the Patent Office to establish anticipation, the Patent Office must show where in the reference each and every element is taught. Furthermore, the elements of the reference must be arranged as claimed. MPEP § 2131.

As amended, independent claims 1, 15, and 27 recite that the service logic is created in at least one presence detection system. This element is not taught or suggested by Boyer. Boyer teaches that the service logic is created within the Softswitch Programmable Feature Server (SPFS) 201, which has a service logic execution environment (SLEE). This SPFS 201 collects the presence information and generates the service logic that instructs the SLEE to control the communications associated with the user based on presence. Since the SPFS is generating the service logic, the presence detection system described in paragraph 0027 of Boyer is not generating the service logic. Since the presence detection system is not generating the service logic, Boyer does not show the claimed invention. Since Boyer does not show the claimed invention, Boyer does not anticipate claims 1, 15, or 27. Thus, claims 1, 15, and 27 are allowable.

Claims 2-8 and 11-14 depend from allowable claim 1, and are allowable at least for the same reasons. Claims 16-22, 25, and 26 depend from allowable claim 15, and are allowable at least for the same reasons. Claims 28-34, 37, and 38 depend from allowable claim 27, and are

allowable at least for the same reasons. Applicant requests withdrawal of the § 102 rejection of claims 1-8, 11-22, 25-34, 37, and 38 at this time.

Claims 9, 10, 23, 24, 35, and 36 were rejected under 35 U.S.C. § 103 as being unpatentable over Boyer in view of McDowell et al. (hereinafter "McDowell"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Even if the combination is proper, to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. MPEP § 2143.03. If the Patent Office cannot establish obviousness, then Applicant is entitled to a patent.

Applicant initially traverses the combination of Boyer and McDowell as improper. Specifically, the Patent Office has not properly supported the motivation to combine the references. That is, the Patent Office asserts the motivation to combine Boyer and McDowell "lies in the fact that using a GPS system, in addition to the variety of methods to investigate the user's presence would add further diversity to Boyer's invention." This asserted motivation lacks any evidentiary support. Since the motivation lacks actual evidence in support thereof, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper, and the claims are allowable.

The Patent Office does note that both Boyer and McDowell are in the same field of endeavor. However, merely because the references are in the same field of endeavor does not amount to a suggestion to combine the references. MPEP § 2143.01. Thus, the Patent Office's statement about the relatedness of the references does not supply the missing evidence to support the motivation advanced by the Patent Office.

Even if the combination is proper, a point which Applicant does not concede, the combination does not establish *prima facie* obviousness. Specifically, the combination does not teach the creation of the service logic at the presence detection systems as recited in the underlying independent claims. Applicant has previously explained how Boyer does not teach or suggest the element. Nothing in McDowell cures the deficiencies of Boyer. Since the references individually do not teach or suggest the claim element, the combination of references cannot

teach or suggest the claim element. Since the combination does not teach the claim element, the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, the claims are allowable for this reason as well. Applicant requests withdrawal of the § 103 rejection of claims 9, 10, 23, 24, 35, and 36 at this time.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. The references of record do not teach or suggest the distributed generation of the service logic as claimed. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted
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